

REMARKS

Claims 1-5, 11, and 165-167 have been cancelled without prejudice. Claims 6-10, 12, 15, 16, 21, 22, 24, 25, 32, 168-170, 180, 182, 186, and 188 have been amended. Support for the amendments can be found in the specification and claims as originally filed. In particular, support for the amendments to claim 8 can be found at least, for example, in the paragraph bridging pages 3-4 and in Figure 1. Support for the amendments to claim 9 can be found at least, for example, at page 4, lines 5-7 and in Figure 2. Accordingly, claims 6-10, 12-41, 62, and 168-206 will be pending after entry of the instant amendment.

Claims 6-10, 12-41, 62, and 168-206 will be pending after entry of the instant amendment. Applicants acknowledge with appreciation the withdrawal of previous objections and/or rejections as outlined on page 3 of the Office Action. Applicants address the remaining objections and rejections as follows:

i) Specification –Sequence Rules

The Examiner objects to the specification for disclosing nucleotide and/or amino acid sequences in Table 17 which fail to comply with the requirements of 37 CFR 1.821 through 1.825. Applicants respectfully submit that Table 17 of the instant application does not disclose a nucleotide or amino acid sequence within the meaning of 37 CFR 1.821(a) (1) or 37 CFR 1.821(a)(2). Nucleotide and/or amino acid sequences as used in 37 CFR 1.821 through 1.825 are interpreted to mean an unbranched sequence of four or more amino acids or an unbranched sequence of ten or more nucleotides, respectfully. Table 17 discloses single amino acid residues. Accordingly, Applicants respectfully request that this objection be withdrawn.

I. II) STATUTORY DOUBLE PATENTING

The Examiner has *provisionally* rejected claims 1-41 and 62 under 35 U.S.C. 101 as being drawn to the “same invention” as that of claims 1-41 and 62 of copending Application No. 10/232,030. The Examiner has also *provisionally* rejected claims 1-41 and 62 under 35 U.S.C. 101 as being drawn to the “same invention” as that of claims 1-41 and 62 of copending Application No. 10/388,389.

Applicants respectfully traverse. None of claims 1-41 and 62 of copending Application No. 10/232,030 and claims 1-41 and 62 of copending Application No. 10/388,389 have been allowed. Applicant's seek allowance of the enumerated claims in the instant application and intend to cancel any conflicting subject matter from each of Application Nos. 10/232,030 and 10/388,389 as appropriate.

Withdrawal of the provisional rejections under 35 U.S.C. 101 is respectfully requested. However, should the Examiner maintain said provisional double patenting rejection(s) as the sole remaining rejection(s) in the instant application, Applicant's respectfully request that the rejection be withdrawn as provided by MPEP section 804, subsection I. B., which states:

"If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patent rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent."

iii) Claim Rejections - 35 U.S.C. 112, First Paragraph

The Examiner has rejected claims 1-41, 62, and 165-206 under 35 U.S.C. 112, first paragraph as allegedly containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner has indicated that the requirement of 35 U.S.C. 112 may be satisfied by a deposit of the 3D6 monoclonal antibody, but that no indication in the specification has been given as to the public availability of the 3D6 antibody.

Applicants hereby submit that the specification has been amended to identify the cell line producing the 3D6 antibody which was deposited with the ATTC. Thus, the amendments to the specification contain no new matter.

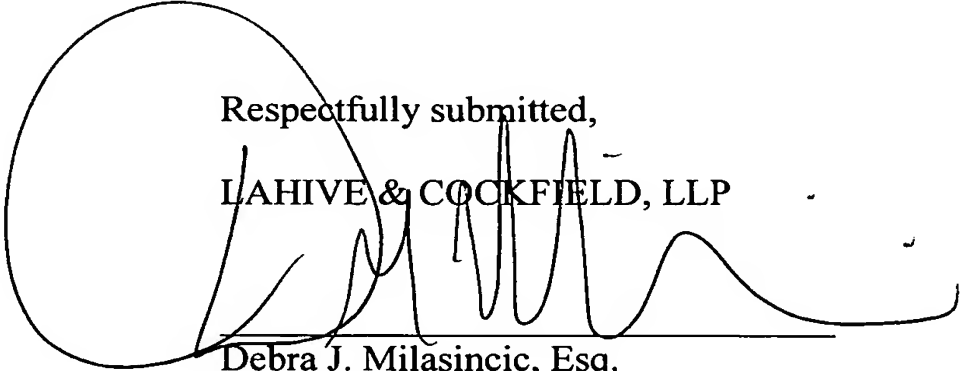
Applicants deposited the cell line producing the antibody 3D6 with the ATCC on April 8, 2003. Applicants submit a statement under MPEP § 2406.02 herewith. Applicants have amended the paragraphs beginning on page 108, line 13 of the specification to recite the name and address of the depository, the accession number for the deposit, and deposit date of the cell line producing the 3D6 antibody. This amendment does not add new matter (*see In re Lundak*, 227 USPQ 90 (Fed. Cir. 1985) and MPEP § 2406.01).

CONCLUSION

If a telephone conversation with Applicants' Attorney would expedite the prosecution of the above-identified application, the examiner is urged to call the undersigned at (617) 227-7400.

Respectfully submitted,

LAHIVE & COCKFIELD, LLP



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Attorney for Applicants

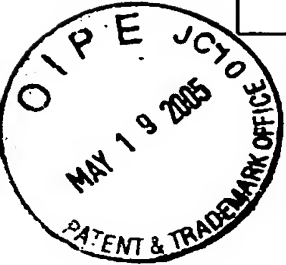
28 State Street
Boston, MA 02109
Tel. (617) 227-7400
Dated: May 9, 2005

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 418604095 US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below

Dated: May 19, 2005

Signature: 

(Debra J. Milasincic)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Guriq Basi *et al.*

Serial No.: 10/010,942

Filed: December 6, 2001

For: *Humanized Antibodies that Recognize Beta Amyloid Peptide*

Attorney Docket No.: ELN-002

Group Art Unit: 1647

Examiner: Christopher J. Nichols

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT UNDER MPEP § 2406.02

Dear Sir:

The undersigned attorney of record, authorized to act on behalf of the Applicant and Assignee in matters relating to the subject Patent Application, does hereby declare and state that:

1. The cell line designated RB96 3D6.32.2.4 producing the antibody 3D6 described at *e.g.*, the paragraph beginning on p. 108, line no. 13 of the above-captioned application was deposited at the American Type Culture Collection on April 8, 2003 and given accession number PTA-5130. The address of the American Type Culture Collection (ATCC) is 10801 University Boulevard, Manassas, VA 20110-2209. The deposit was made pursuant to the provisions of the Budapest Treaty. A copy of the ATCC receipt is attached as Exhibit 1.

2. The antibody 3D6, produced by the cell line identified in paragraph 1, is also described at *e.g.*, the paragraph beginning on p.62, Example IX of U.S. Application No. 60/251,892, filed December 6, 2000. The instant application claims the benefit of the filing date of U.S. Application No. 60/251,892.

3. The cell line identified in paragraph 1 above will be maintained at the ATCC and replaced in the event of mutation, nonviability or destruction for a period of at least five (5) years after the most recent request for release of a sample was received by ATCC, for a period of at least thirty (30) years after the date of the deposit, or during the enforceable life of the related patent, whichever period is longest.

4. All restrictions, on the availability to the public of the cell line identified in paragraph 1 above will be irrevocably removed upon the issuance of a patent from the above-captioned application.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: May 19, 2005

LAHIVE & COCKFIELD, LLP
Attorneys at Law

By 

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BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3 AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.

To: (Name and Address of Depositor or Attorney)

Elan Pharmaceuticals, Inc.
Attn: Nina Ashton
800 Gateway Boulevard
South San Francisco, CA 94080

Deposited on Behalf of: Elan Pharmaceuticals, Inc.

Identification Reference by Depositor:

Murine Hybridoma Cell Line: RB44-10D5.19.21
Murine Hybridoma Cell Line: RB96 3D6.32.2.4

Patent Deposit Designation

PTA-5129
PTA-5130

The deposits were accompanied by: a scientific description a proposed taxonomic description indicated above. The deposits were received April 8, 2003 by this International Depository Authority and have been accepted.

AT YOUR REQUEST: X We will inform you of requests for the strains for 30 years.

The strains will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strains, and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strains.

If the cultures should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace them with living cultures of the same.

The strains will be maintained for a period of at least 30 years from date of deposit, or five years after the most recent request for a sample, whichever is longer. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the cultures cited above was tested May 5, 2003. On that date, the cultures were viable.

International Depository Authority: American Type Culture Collection, Manassas, VA 20110-2209 USA.

Signature of person having authority to represent ATCC:

Marie Harris
Marie Harris, Patent Specialist, ATCC Patent Depository

Date: June 2, 2003

cc: Joe Liebeschuetz

Ref: Docket or Case No.: 15270J-004720US

Exhibit 1